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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/511,441	05/03/2005	Tomoji Maruyama	260364US90PCT	9474
22850	7590	12/11/2006		
C. IRVIN MCCLELLAND OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314				
			EXAMINER YABUT, DIANE D	
			ART UNIT 3734	PAPER NUMBER

DATE MAILED: 12/11/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/511,441

Applicant(s)

MARUYAMA ET AL.

Examiner

Diane Yabut

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 20 November 2006.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) 9-24 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 25 October 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 10/25/04; 1/10/05.

- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Election/Restrictions*

1. Applicant's election with traverse of Species I (Figures 1-17 and Claims 1-8) in the reply filed on 20 November 2006 is acknowledged. The traversal is on the ground(s) that the disclosed species require a single search and not impose an unduly, serious burdensome requirement on the Examiner. This is not found persuasive because each of the species is patentably distinct from the other and do not overlap in scope are and are not obvious variants of each other. Therefore these alternative structures would require more than a single search and impose a burden on the Examiner.

The requirement is still deemed proper and is therefore made FINAL.

2. Claims 9-24 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected Species 2-9, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on 20 November 2006.

### *Priority*

3. A claim for priority under 35 U.S.C. 119(a)-(d) cannot be based on said application, since the United States application was filed more than twelve months thereafter.

***Information Disclosure Statement***

4. The information disclosure statements (IDS) submitted on 25 October 2004 and 10 January 2005 are acknowledged. The submissions are in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statements are being considered by the examiner.

***Specification***

5. This application does not contain an abstract of the disclosure as required by 37 CFR 1.72(b). An abstract on a separate sheet is required.

***Claim Objections***

6. Claims 3-8 are objected to because of the following informalities: On line 1 of each of Claims 3-8 it reads "An organism" and should read --The organism--. On line 2 of Claim 8 it reads "a tear end" and should rather read --a rear end--. On lines 4-5 of Claim 7 it reads "stopped said hollow needle members a position of pressed by said needle member operation portion" and should be changed to --stopper means stopping said hollow needle members at a position pressed by said needle member operation portion-- or to something that clearly states what the stopper means function is.

Appropriate correction is required.

Note: In lines 3-4 of Claim 7 it reads "stopper means" but does not invoke 35 U.S.C. 112, sixth paragraph.

***Claim Rejections - 35 USC § 112***

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claim 8 recites the limitation "said opening" in line 2. There is insufficient antecedent basis for this limitation in the claim.

***Claim Rejections - 35 USC § 102***

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

10. Claims 1-4 and 7-8 are rejected under 35 U.S.C. 102(b) as being anticipated by **Kontos** (U.S. Patent No. **5,855,585**).

Claim 1: Kontos discloses a body part **18** with a predetermined length having a rotary portion **22** and can be inserted into said tissue of an organism from a penetrated hole, a needle member **56** accommodated in a portion, inside said body part, rearward from said rotary portion, and a pressing mechanism **58** for advancing said needle member from a side surface of said body part and pressing said needle member into said rotary portion, wherein said rotary portion has a needle member receiving portion **72** for receiving essentially a front end of said needle member pressed into said rotary portion by said pressing mechanism, with said rotary portion disposed in said tissue of said

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organism, and said needle member having a suturing thread or a duct **59** for said suturing thread duct (Figure 16 and col. 7, lines 20-59).

Claim 2: Kontos disclose a body part, with a predetermined length, having a rotary portion **22** and can be inserted into said tissue of said organism from said hole, two hollow needle members **37** accommodated in a portion, inside said body part, rearward from said rotary portion, a needle member operation portion **43, 43'** for advancing said hollow needle members toward said rotary portion from a side surface of said body part, and two openings **26, 28** disposed at a rear portion of said body part and communicating with an inside of said two hollow needle members, wherein said rotary portion has two needle member receiving portions **32, 32'** for receiving a distal end of one of said hollow needle members and that of the other of said hollow needle members respectively pressed out of said body part, and a connection duct **33** communicating with said two needle member receiving portions, and a duct for a suturing thread being formed in a range from one of said two openings to the other of said openings through an inside of one of said two hollow needle members, when said two hollow needle member receiving portions receive said hollow needle members respectively (Figures 1-4B, 6B-8, and col. 5, lines 41-67 to col. 6, lines 1-56).

Claim 3: Kontos discloses a suturing member **41'** which can be inserted into said duct for a suturing thread **41**, and said suturing member including a guide portion linearly formed of an elastic material and a suturing thread portion provided on said guide portion (Figures 1-4B, 6B-8).

Claim 4: Kontos discloses said rotary portion has a thread pull-out slit extending from an upper surface thereof and communicating with said two needle member receiving portions and said connection duct (Figure 6B).

Claim 7: Kontos discloses an urging member **43, 43'** for urging said needle member operation portion or said hollow needle member rearward and a stopper means stopping said hollow needle members at a position pressed by said needle member operation portion (col. 6, lines 1-56).

Claim 8: Kontos discloses said opening being formed at a rear end of said needle member operation portion (Figures 1-4B, 6B-8).

***Claim Rejections - 35 USC § 103***

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. Claims 5-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Kontos** (U.S. Patent No. **5,855,585**) in view of **Kortenbach** (U.S. Patent No. **6,096,051**).

Claims 5-6: Kontos discloses the claimed device except for a rotary portion towing wire which extends inside said body part and is fixed to said rotary portion at one end thereof, wherein said body part has a supporting pin for rotatably supporting said rotary portion, and said rotary portion having a side-surface opening, for receiving said

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supporting pin, formed long and axially extending to allow sliding of said supporting pin, a rotation angle restriction function permitting a rotation of said rotary portion between a state in which said rotary portion is on an approximate extension line of an axis of said body part and a predetermined angle less than 90 degrees.

Kortenbach teaches a rotary portion towing wire which extends inside said body part and is fixed to said rotary portion at one end thereof, wherein said body part has a supporting pin for rotatably supporting said rotary portion, and said rotary portion having a side-surface opening, for receiving said supporting pin, formed long and axially extending to allow sliding of said supporting pin, and a rotation angle restriction function permitting a rotation of said rotary portion between a state in which said rotary portion is on an approximate extension line of an axis of said body part and a predetermined angle less than 90 degrees (Figures 6D-6F). It would have been obvious to one of ordinary skill in the art at the time of invention to provide a rotary portion towing wire and pin and a rotation angle restriction function, as taught by Kortenbach, to Kontos, since it was known in the art that the rotary portions commonly have pins for hinges to allow for secure rotation as well as rotation restriction functions to avoid undesirable movement of the apparatus that may injure tissue.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Diane Yabut whose telephone number is (571) 272-6831. The examiner can normally be reached on M-F: 9AM-4PM EST.



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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Hayes can be reached on (571) 272-4959. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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MICHAEL J. HAYES  
SUPERVISORY PATENT EXAMINER